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PATENT TRADEMARK OFFICE

Atty. Docket: 7962801/0503762

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Adam G. Malofsky et al. : Paper No:

Serial No. 09/840,859 : Group Art Unit: 1771

Filed: April 24, 2001 : Examiner: Daniel R. Zirker

For: FASTENING DEVICE

RESPONSE TO RESTRICTION REQUIREMENT

THE ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Dear Sir:

In response to the Office Action, dated August 7, 2002, relating to the above patent application, please consider the following remarks.

In that Office Action, the Examiner requested that the Applicants make an election to prosecute one of what the Examiner alleges to be four separate inventions:

- I. Claims 1-67, drawn to a fastening device
- II. Claims 68-101, drawn to a method for bonding surfaces together
- III. Claims 102-106, drawn to a method for bonding surfaces together
- IV. Claims 107-112, drawn to method of bonding surfaces together.

This restriction requirement is traversed, at least in part, because the premises which support the Examiner's conclusions are erroneous.

In paragraph 5 of the Office Action, the Examiner alleges that Group II and I are related as a process of making and the product made. This is incorrect. The Group I claims cover a product (a fastening device), and the Group II claims cover the method of using that same product. Therefore, the claims of Group I and II are related in terms of a product and a method of using that product. In fact, claims 68-95 in Group II are all dependent from the

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claims in Group I, so that the Group II claims cover the method of using the specific devices which are claimed by the Group I claims. The MPEP, in § 806.05(h), states that a product and a process of using that product (the situation we have here) can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with other materially different products; or (B) the product as claimed can be used in a materially different process. Neither of these situations exist in the present case. Since the claims in Group II are dependent from the claims in Group I, they are claiming a method of using the specific devices claimed in Group I. Those method of use claims cannot be applied to any device other than the devices covered in Group I. Therefore, the condition defined in (A) above cannot be met. Further, the process described in the Group II claims is specifically adapted to the type of products covered in Group I. Specifically, the Group I device is placed against a surface, and the device is heated (for example, by induction heating) to activate the adhesive in the device. Since the Group II process is specifically adapted for use with the Group I products, the condition described in (B) above can also not be met. Since neither conditions (A) nor (B) can be met, restriction between the claims of Group I and the claims of Group II is improper, and those two groups of claims must be considered together.

Further, it should be pointed out that because claims 68-95 of Group II are all dependent from the claims of Group I, any search of the method of use (Group II) claims would by necessity require a search of the device claims since those are the specific devices which are being used in the method of use. The scope of the search of the claims of Group I and the claims of Group II would therefore be coextensive. MPEP § 803 states that even if two inventions are patentably distinct (which, in fact, is not the case with the Group I and Group II claims herein), then a restriction requirement is still improper if to consider them

together would not place a serious burden on the Examiner. In this case, since the searches for the two groups of claims are essentially identical, there would not be a serious burden placed on the Examiner by considering the Group I and Group II together, and, therefore, the restriction requirement is also improper on that basis, as well.

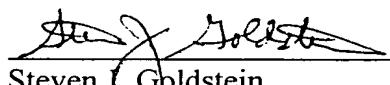
Applicants would like to make several additional comments regarding errors in the assumption which underlie the Examiner's restriction requirement. Specifically, in paragraph 6 of the Office Action, the Examiner indicates that the claims of Group III and the claims of Group II are related in terms of a process of making and the product made. Once again, that is incorrect. The invention of Group III is a method of using the devices defined in the Group I claims, and Group II also defines a method for using the devices claimed in the Group I claims. Therefore, Group III and Group II define closely-related methods for using the devices defined in the Group I claims. In paragraph 8 of the Office Action, the Examiner indicates that the inventions of Group I and Group II are unrelated. As described above, this also is clearly incorrect. The Group I and Group II claims are related in terms of a product and the method of using that product. Finally, in paragraph 12 of the Office Action, the Examiner indicates that a telephone call was made to Applicants' undersigned attorney on August 5, 2002, to request an oral election in the restriction requirement. Based on the attorney's telephone records, this telephone call was not received by the Applicants' undersigned attorney either on August 5 or on any other date.

Based on the foregoing, it is respectfully submitted that all of the alleged inventions defined by the Examiner are related and, therefore, the restriction requirement should be withdrawn. In any event, since the separation by the Examiner of Groups I and II runs counter to MPEP §§ 806.5(h) and 803, those claims must be considered together. Applicants, therefore, provisionally elect to prosecute Claims 1-101 (i.e., the claims of Groups I and II,

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considered together) in the present application. In the alternative, Applicants provisionally elect claims 1-95, since all of those claims are specifically tied (by dependency) to the devices claimed in Group I. Finally, in the event that the Examiner does not combine those claims and consider them together, Applicants provisionally elect the claims of Group I (i.e., Claims 1-67) for prosecution in this application.

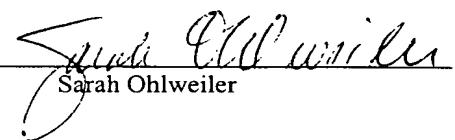
Respectfully submitted,
Adam G. Malofsky, et al.


Steven J. Goldstein
Registration No. 28,079
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202-4182
Telephone (513) 651-6131

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I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to The Assistant Commissioner of Patents, Washington, D.C. 20231 on

August 30, 2002.


Sarah Ohlweiler

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